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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 2004/01/27

Application Number: 09/543,653

Filing Date: April 05, 2000

Appellant(s): KAWAMOTO ET AL.

Keiichi Nishimura
For Appellant

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EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/22/03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is not correct. The changes are as follows: Issues 1 and 3 are moot because the Examiner, agreed that Applicant had overcome the 35 USC 112 1st paragraph rejections and rejections under Grimm and withdrew those rejections, as indicated at paragraphs 3 and 5 of the 10/15/2003 Advisory Action.

(7) *Grouping of Claims*

The rejection of all claims stand or fall together because appellant's brief states same, See 37 CFR 1.192(c)(7).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

| | | |
|------------------|----------------|----------------|
| 5,367,282 | Clem | 11-1994 |
| 4,276,536 | Wisnia | 6-1981 |
| 3,087,134 | McOrlly | 4-1963 |
| 03-209704 | Katsuki | 9-1991 |

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 21, 26, and 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by McOrlly. McOrlly discloses the claimed invention at Figs. 2-3 with sensing element 12, with the electrodes for claims 1, 21, and 26 either 16, or 116, or the straight end portions of the coiled resistor 12 where lead lines 16, 116 attach thereto. Or the electrodes are junctions between where 12 and 16, 116 attach, including or not including securing means disclosed. The lead lines are include kinked parts 32, 132 and may include portions 15, 115. Or the lead lines are the portions 33, 133, with kinked parts 32, 132, and lines 16, 116, all of which may be integral and all of which are thus flexible, see col. 3, lines 15-27. For claim 26 and 29, the

kinked part is between the collinear portions 133 and 116, and between collinear portions 33 and 16, and may also include collinear portions 15, 115. For claims 1, 21, and 29-30, the kinked parts 32, 132 are “bent in the same direction with respect to each other to form said kinked part”, and then after being so formed, are attached in different directions. That is, the term is a product by process limitation, whereby the process of bending has been used, and one can see that the lead lines have been bent in the same direction by laying one on top of another mentally or figuratively. The final product does not require that the bent parts extend in the same direction because the claim states “bent ..to form said kinked part such that the kinked parts on said lines are in a side-by-side relationship”. That is the claim requires bending TO FORM in a side by side relationship in the final product. For claim 21, the stage at Fig. 3 discloses the kinked parts externally exposed, where same are exposed immediately after 32 and 16, and 132 and 116 are attached.

Claims 1, 21, 26, and 28-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Katsuki (JP 3-209704). Katsuki discloses the claimed invention at Fig. 1a with sensing element 11, electrodes 12, and lead lines 13 having externally exposed semicircular kinked parts proximal to the ends bent in the same direction with respect to each other. For example the bottom most bend and the first bend on the top are each bent to the right and downward. In claim 28, one sees the cover 14 extending over parts of the lead lines 13 at the ends, as noted in the abstract. In claims 26 and 29, there are two collinear portions in Fig. 1b. with two of the bends to the right, or to the left. The kinked parts are sandwiched between two collinear parts even though the sandwich has a kink in it (like a sandwich with tomato and baloney). Likewise, the kinks are in a “side-by-side” relationship even though there is a resistor between them where

there is no disclosure for the term, and applicant's Fig. 4 discloses a circuit board between the leads so that the term "side-by-side" does not preclude something between same.

Claims 6, 23-24, 27, 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katsuki (JP 3-209704), or McOrlly, as applied to claims above, and further in view of Clem. The noted art discloses the claimed invention except the material of the leads. Clem discloses the material at col. 3 for lead attachment to a thermistor, and it would have been obvious to employ the well known material for good lead attachment where thermistors are employed.

Claims 8, 25, and 33 and are rejected under 35 U.S.C. 103(a) as being unpatentable over Katsuki (JP 3-209704), or McOrlly., as applied to claims above, and further in view of Wisnia. The claimed invention is disclosed as noted above except for the NTC thermistor. Wisnia at col. 1 and the abstract discloses thermistors having NTC properties for temperature sensing, and it would have been obvious to employ any of the two only possible types of sensors where Katsuki and Grimm disclose thermistor sensors generically for sensing temperature.

(11) Response to Argument

Only two issues argued by applicant are subject to appeal. As noted above, under the "ISSUES" section, Issues 1 and 3 presented by applicant are moot because the Examiner, in the noted Advisory Action, agreed that applicant was persuasive as to those issues.

Thus only applicant's Issues 2 and 4 are before the Board. Applicant on page 5, frames Issue 2 as: "[w]hen two components are bent in the same direction before being installed to a device are bent in different directions when installed to the device, does the device having these components bent in different direction anticipate a claim limited as having two components

bent in the same direction ?” Applicant frames this issue as it pertains to the McOrlly rejection of claims 1, 21, 26, and 29-30..

However, Claim 26 lacks any requirement for the kinks to be bent in the same direction. Applicant states in Section VII of his Brief, that all claims stand or fall together. Thus, since claim 26 does not require the “bent” limitation, claim 26 must fall. There is no separate argument regarding claim 26 and the rejection under McOrlly. Thus all claims must fall together under Issue 2. Similarly, under Issue 4, Applicant argues only that Katsuki does not disclose the “side-by-side” limitation. Independent claim 26 does not require the “side-by-side” limitation. Thus, since claim 26 does not require the “side-by-side” limitation, claim 26 must fall under Issue 4 too. Thus, likewise all claims must fall together under Issue 4. Thus, for two reasons,¹ under McOrlly Issue 2 and Katsuki Issue 4, all claims must fall together

Assuming arguendo, that the Board does not find all claims must fall rejected together under Issue 2, the Examiner disagrees that “bent in the same direction” requires the two kinked parts to remain in the same direction in the final product. First, as this Board has said on numerous occasions, “the name of the game is the claims”. As noted, claim 26 does not require the limitation, so it and its dependant claims 27-28 fall as rejected. For claims 1 and 21, claim 21 reads “said lead lines being bent in a same direction with respect to each other to form said kinked part such that said lead lines are in a side-by-side relationship”.²

Thus, claim 21, as seen above, requires only that the kinked parts are in a side-by-side relationship in the final product. This is because the final product is defined by what follows the

¹ Applicant was also notified in the Advisory Action of 10/15/03, par. 5, of the failure to argue claim 26.

² Applicant states on page 5 of his Brief that the McOrlly leads have the “two components...bent in the same direction before being installed to a device”, as noted above. Therefor, the examiner and applicant agree that the McOrlly leads are bent in the same direction before installation.

“bent... to form” clause – the “side-by-side relationship”. There is nothing after the clause “to form” that requires the kinks to exist in the product’s final form in the same direction.

That is, the claim does not recite: “bent to form the kinks in a same direction”. Hence, applicant’s argument must fail because any requirement for kinked parts to be in the same direction must come after the “to form” clause. This is a broad, straight forward, reasonable interpretation of the claims under normal rules of grammar. Thus, “bent [in a same direction or in some manner] to form [so that the kinked parts end up in a side-by-side]” means that the first bracketed phrase defines how to form or make the product, while the second bracketed phrase dictates the final form. Consequently, the first phrase clearly defines only a product-by-process limitation of how to form and imparts no “same direction” limitation in the final product.

Thus, under Issue 2, the element “lead lines being bent in a same direction ...to form” is a limitation only on how the leads are bent initially. For example, if the claim had read: “lead lines bent in the same direction by a glove wearing bender who is six feet tall to form...”, surely gloves on a six feet tall glove wearing bender would not be required to satisfy the final form of the product in a product claim, anymore than would the final product require the bent kinks to be in the same direction, especially where the clause reads “bent...to form”.

As to the final remaining Issue 4, Applicant argues on pages 6 and 9 of his brief, that the Katsuki rejection of claims 1,21,26, and 28-30 is incorrect because Katsuki lacks the teaching of the “side-by-side” element in the kinks in the claims. Of course, as noted above, claims 26 and 27-28 have no “side-by-side” requirement, so that those claims must fall together. Hence, this response assumes that the Board treats claims 1 and 21 as standing apart from claim 26.

With respect to the “side-by-side” element and Katsuki, Applicant argues at the bottom of page 9 that “the issue is not whether something else is in between but the size of the objects relative to the separation that determines whether or not it is proper to describe two objects as being in a side-by-side relationship”. Applicant clarifies his argument on page 9, by stating that two tall buildings separated by a small wading pool are “side-by-side”, but if separated by a big wading pool, are not “side-by-side”³.

But there is no basis in this specification for such a definition. Webster’s Third New International Dictionary (see Appendix) defines “side-by-side” as “1: beside one another...” while the term “beside” is defined as “at or to the side..” or “to the side of”. Surely, in Katsuki, one kink is to the side of the other. For example, the kinks in Figs. 1a and b in the leads 13 are to the side of each other, for example, to the left-hand side, or right-hand side. Thus, Katsuki meets the dictionary definition.

On the other hand, Applicant’s definition is based upon an unsupported distinction based only on size of the Katsuki resistor between the kinks, or more specifically, the distance between kinks. His arguments necessarily mean that his claims would read on the Katsuki device if the Katsuki resistor were physically smaller. That is, a small resistor between the two kinks renders the kinks “side-by side”, but a large one does not, according to applicant’s argument, because then the kinks would be closer together. For example, applicant argues that a ratio of kink distance to kink size of ten, is too big to meet the “side-by-side” relationship. But, what about a five to one ratio? For example, the distance between the kinks in Katsuki Fig. 1a that

³ Similar to the agreement noted in footnote 1, applicant and the examiner agree that “side-by-side” does not preclude something in-between the two kinked parts, such as a resistor. See also applicant’s Fig. 4, with a circuit board inbetween kinks.

are bent in the same direction are about 40mm apart, but each kink is about 8mm long, leaving a five to one ratio.

Applicant's argument requires the Board to limit "side-by-side" in terms of a kink distance to size ratio less than ten, yet his own argument suggests a five to one ratio in the Katsuki figures. And MPEP 2173.05(b) dictates, "[w]hen relative terms are used in claims wherein the improvement over the prior art rests solely upon size or weight of an element in a combination of elements the adequacy of the disclosure of a standard is of greater criticality". See Amgen, Inc. v. Chugai Pharmaceutical Co., 927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991)(requiring a range specificity to avoid close prior art). As there is no disclosure of the size limitation of "side-by-side", it is essentially a relative term, akin to those running afoul of Amgen, because here as in that case, the only difference between the prior art and the invention is the size of the resistor, as admitted. Thus, to allow applicant to read into his "side-by-side" limitation a kink distance to size ratio, based upon a later use of a ruler on a prior art document, would be to allow an end around the 35 USC 112 1st paragraph written description requirement, and 2nd paragraph definiteness requirement, because there is no original description for such a size limitation, and applicant attempts to distinguish close prior art in terms of a size limitation in a relative term. The term "side-by-side" does not appear in the specification.

There is no basis for applicant's argued definition, other than applicant's unfounded conjecture and use of a ruler on the Katsuki figures. So if the rejection were to be reversed based on this argument, it would essentially allow applicant's claims to capture or read on a smaller type of Katsuki resistor, and at the same time, avoid the disclosed larger Katsuki resistor. But such a decision would not only ignore the dictionary definition above, and run

afoul of 35 USC 112 1st and 2nd paragraph dictates, it would also violate In Re Graves, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995) (reference anticipates the claimed invention if the element that is not disclosed therein is within the knowledge of the skilled artisan), because a smaller resistor, while holding kink size constant, is surely contemplated by Katsuki even if not explicitly disclosed. That is, Katsuki, under the In Re Graves dictates, teaches by implication that the invention would apply to any size of resistor, even if smaller sizes are not explicitly disclosed. See also In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPJA 1955)(limitations relating to the size of the package were not sufficient to patentably distinguish over the prior art); Gardner v. Tech, Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (FED.Cir. 1984) cert. denied, 469 US 830, 225 USPQ232 (S.Ct. 1984)(where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device). Thus, In re Graves dictates that it is what a reference teaches to one of skill in the art that matters, not what is explicitly in the reference, while In re Rose, and Gardner indicate that size is a legally known, recognizable quantity, that could be recognized to one of skill in the art as implicit in a teaching reference under the reasoning of In re Graves. Surely, one of skill would know that any kink size to kink distance is contemplated in the disclosure of Katsuki. For example, the top of page 4, and page 6 of the English translation of Katsuki discloses a desire for “compact” thermistor sizes. Yet, applicant bases his definition on approximations of his ruler on a figure in Katsuki. Applicant attempts to limit the teachings of Katsuki with his ruler, as if Katsuki teaches only what is in the figure, directly contrary to In re Graves.

To conclude, under established procedures, because applicant argues that all claims stand or fall together, and makes no separate argument for different claims, then all claims must fall with claim 26. Finally, Katsuki and McOrlly disclose the invention as noted above.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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KDE
February 23, 2004

Appeal Conference Conferees



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APPENDIX – attached dictionary Definition of “side-by-side” and “besides”.